Remarks

Claims 1-20, 24, 37, 40, 41 and 43 were pending in the subject application. By this Amendment, applicants have hereinabove cancelled claims 19, 40 and 41 without disclaimer or prejudice to applicant's right to pursue the subject matter of these claims in the future. Applicants have also amended hereinabove claims 15, 18 and 20.

Accordingly, claims 1-18, 20, 24, 37, and 43 are pending.

Restriction Requirement Under 35 U.S.C. §121

In the February 19, 2009 Office Action, the Examiner required restriction to one of the following groups under 35 U.S.C. §121:

I. Claim(s) 1-6, 8-14, 40, 41, and 43 drawn to a grain obtained from rice wherein the rice grain comprises a reduced level of SBEIIa and SBEIIb and comprises a transgene and a method of producing a rice starch thereon.

II. Claim(s) 1-4, 7-17, 24, 37 and 40 drawn to a grain obtained from rice wherein the rice grain comprises a reduced level of SBEIIa and SBEIIb and comprises introducing variations via mutagenizing or identifying null mutants, including Wxa.

III. Claim(s) 18-20, drawn to a starch or starch granule and flour.

The Examiner alleged that the inventions are distinct, each from the other, because each of the inventions requires

consideration of separate issues relating to assessment of novelty, obviousness, utility, written description and enablement.

Applicants' Response

In response, applicants hereby elect, with traverse, to prosecute the invention of Examiner's Group I, drawn to a grain obtained from rice wherein the rice grain comprises a reduced level of SBEIIa and SBEIIb and comprises a transgene and a method of producing a rice starch therefrom. However, applicants respectfully traverse the rejection of claims 15, 16, 18 and 20 from this group.

Applicants have hereinabove amended claim 15 to clarify that the grain of claim 2, which is within Group I, "further" comprises a null mutation of SBEIIa and SBEIIb. Claim 15 is therefore within elected Group I.

Claim 16 further defines the grain of claim 1 within Group I. There is no basis of record to restrict claim 16 from claim 1. Accordingly, claim 16 should be examined with elected Group I.

Applicants have also amended hereinabove claims 18 and 20 to independent format reciting all the limitations of claim 1, within Group I. Applicants state for the record that rice granules of applicants' invention are not patentably distinct from the rice grain of applicants' invention. Therefore, claims 18 and 20 must be examined with elected Group I.

35 U.S.C. §121

Applicants traverse the restriction on the basis that 35 U. S. C. §121 states, in part, that "[i]f two or more independent

and distinct inventions are claimed in one application, the Director may require application to be restricted to one of the inventions." [Emphasis added]. Applicants request that the restriction requirement be withdrawn in view of the fact that the claims of Groups I-III are not independent.

Under M. P. E. P. §802.1, "independent" means "there is no disclosed relationship between the subjects disclosed, that is, they are unconnected in design, operation, and effect ... ". The claims of Group I-III are related in that they are drawn to similar compounds, compositions, and methods of use. All of the methods relate to inhibition of SBEIIa and SBEIIb.

Applicants therefore respectfully assert that two or more independent and distinct inventions have not been claimed in the subject application because the groups are not independent under M.P.E.P. §802.01. Therefore, restriction is improper under 35 U. S. C. § 121.

Additionally, applicants point out that under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden. There are two criteria for a proper requirement for restriction, namely (1) the invention must be independent and distinct; AND (2) there must be a serious burden on the Examiner if restriction is not required.

Applicants maintain that there would not be a serious burden on the Examiner if restriction were not required. A search of prior art with regard to any of Groups I, II or III would identify art for the other Group. Since there is no serious

burden on the Examiner to examine Groups I-III in the subject application, the Examiner must examine the entire application on the merits.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement and examine all pending claims on the merits.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorneys invite the Examiner to telephone at the number provided below.

No fee is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being deposited on this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:

Mail Stop Amendment
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Alexandria, VA 22313-1450

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